16776

No. xxiii. 139

Brief of Dane for Respondent

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1899.

Filed Oct. 17, 1899.

No. 410.

Office Supreme Court U. S.
FILED
OCT 17 1899
JAMES H. McKENNEY,
Clerk.

CLARENCE W. HOBBS *et al.*,
Petitioners,

vs.

FRED H. BEACH,
Respondent.

BRIEF FOR RESPONDENT.

JOHN DANE, JR.,
Counsel for Respondent.

16777

Supreme Court of the United States.

OCTOBER TERM, 1899.

CLARENCE W. HOBBS *et al.*

vs.

FRED. H. BEACH.

No 410.

Brief and argument of respondent in opposition to the petition of Clarence W. Hobbs *et als* for a writ of certiorari.

[Statement.]

The petition of Hobbs *et als* is faulty in that it does not set forth proper and sufficient grounds to justify the granting of the writ as prayed. It does not clearly set out the supposed errors of law. It does not state sufficient of the evidence to enable the Court to understand the real facts in the case, while some of the statements set out in their petition are misleading in their character.

Referring to the matters set forth in each section of petitioner's specification, commencing with the

FIRST.

Respondent admits that patent No. 442,582 was granted to J. A. Horton, December 9th, 1890, and that some machines have been made substantially in accordance therewith.

SECOND.

Respondent admits that a suit was brought by Fred H. Beach, in the said District of Massachusetts, based upon Reissued Letters Patent No. 11,167, granted May 26th, 1891, which suit was disposed of by the Circuit Court, in part, for complainant, and in part for defendant, also by the Circuit Court of Appeals in and for the First Circuit who decided **all** points in favor of complainant, Beach. The original application was filed by Beach, June 10th, 1885, and was placed in interference with five (5) different applicants living in different cities of the Union; each of the applications being based upon the same subject matter as that of the Beach pending application. These interference proceedings extended over a period of about five (5) years of time, during which all actions relating to said application of Beach (excepting, of course, questions relating to priority of invention), were suspended under the rules until after the final determination of the issues by various appellate tribunals of the Patent Office.

THIRD.

Said Horton application, upon which patent No. 442, 582 was granted, was filed March 28th, 1890, with limitations in the claims thereof that in scope were not broad enough to embrace or to conflict with any of the pending claims of Beach, consequently, such limitations made it unnecessary for the Commissioner of Patents to declare an interference between the applications of Beach and Horton. (See claims of Beach patent, page 610 Record, and those of the Horton patent, page 317 Record.)

FOURTH.

The Averment of Petitioners, "that owing to limitations "imposed by the Commissioner of Patents upon the Beach "claims there was no interference in fact, or, in law, between "the pending applications of Beach and Horton," is (we submit) misleading, for as a fact the limited character of the Horton claims were such as made it quite unneccessary for the

Commissioner of Patents to put them in interference with any of the Beach claims, or, with the claims of any of the other applicants who contested with Beach for priority of invention before the Patent Office.

FIFTH.

The error which formed the basis for the reissue of the Beach patent was a defect in the drawings of the original patent, which, if followed, would have resulted in the production of a defective and an inoperative machine, therefore, in justice to the public, Beach was justified in curing the defect by reissue and thereby present a proper recipe for the benefit of the public as the laws require in such cases, to which we shall refer more fully hereinafter.

SIXTH.

The statements appearing in the sixth ground of the petition are misleading, doubtless owing to the fact that petitioner's counsel are not familiar with the pleadings and proofs in the New York cases referred to. The statements or quotation from the opinion of Judge COXE, that "infringement of the first three claims is practically conceded," was based upon the admission of defendant's counsel in that case that if the claims were given **"a broad construction,"** then, undoubtedly defendant's machine would infringe, and this, in the face of conceded differences in the **form and arrangement of some of the elements** of the combinations, which the Circuit and Appellate Courts held to be embraced by the scope of the Beach claims: The quotation, that, there was "no proof of infringement by the American Box Machine Company" signifies nothing here, as the "American Box Machine Company" and the Inman Manufacturing Company and others were impleaded in the same bill, as they were conducting their business in the same offices, the latter as manufacturers of the infringing machines, and the former as selling agents, while later on, evidence disclosed the fact that The American Box Machine Company was a *bona fide*

corporation, and the Inman concern a firm; and as no proof of sale or use of corner staying machines by the American Box Machine Company were made, the Court decided accordingly. The statement that, "the machine held as an infringement was a copy of the Beach machine," is misleading and not strictly in accordance with the facts, the differences however between the Hobbs or Horton staying machines and the machine of Beach is no greater than the difference between the Inman and Beach machines. Again, the statement, concerning the decision of Judge Coxe (75 Fed. Rep., 842) wherein he said: "When "he (defendant Inman) persists in producing the old article by "useing a machine which concededly contains all the elements "of the forbidden combination save one, the Court should not "be over zealous to strain the rules of equity in his behalf."

This decision was based upon proceedings involving a machine made, patented, and sold by Inman after the former suit and decision Beach *v.* American Box Co. (73 Fed. Rep., p. 597), and the affirmance of the same by the Court of Appeals, 18 C. C. A., 169. The principal difference between the later and the former machine consisted in the employment of a roller die with diverging faces which was rolled over its counterpart (lower die) and pressed the stay-strips over and upon the box corner by a rolling pressure, instead of a direct vertical action of the die as in the Beach patent, the latter engages and presses the entire surface of the stay-strip at the same moment of time, over and upon the corner of the box operated upon; hence, the expressions of Judge Coxe (which appears on page 841, 75 Fed. Rep.), wherein he compares it with different means for sticking postage stamps, etc. It is submitted, however, that the grounds set forth in the sixth section of the petition are insufficient to justify the granting of the writ sought.

SEVENTH.

It is respectfully submitted that the opinion of the Court of Appeals in the Second Circuit should be considered in the light of the facts before it. Beach distinctly sets forth in

his specification at page 286 of Record, that he does not limit himself to the particular forms and arrangement of the elements described, but that others may be employed, etc., which was allowed by the Commissioner of Patents.

Defendants, Hobbs *et als.*, employed substantially the same essential factors in their stay machines as did M. D. Knowlton whose application in the interference proceedings was declared by the Commissioner of Patents to be embraced by the Beach claims.

The Knowlton machines contained substantially, and, in fact, almost the identical feeding device shown in the Horton patent (adopted by Hobbs *et als.*), which was considered in the interference proceedings, and by New York Courts held to be within the scope of the first three claims of the Beach patent.

Furthermore, the same feeding apparatus is found in the old patent to Van Geasen, No. 192,798, July 3d, 1877, which was before and considered by the Court of Appeals in the First Circuit, at the hearing of this suit, which feeding apparatus was cited against Knowlton's application (see Knowlton's file wrapper, page 313 Rec.), and which doubtless would have been cited by the Patent Office against Horton had he made any claim for his feeding mechanism in his application upon which he secured his patent.

It is submitted that the several opinions and decisions by the Courts of Appeal are the best evidence of what they really cover—their meaning is clear—the expressions contained therein—unmistakable, and, moreover, reasonable—considered in the light of a fair interpretation.

Eighth.

The grounds set out in the eighth section of the petition are admitted, and will be discussed in the argument to follow.

Ninth.

The grounds set forth in the ninth section of the petition,—is an apparent attempt to present a question for considera-

tion and review by the Court, upon which the respective Courts of Appeals of the First and Second Circuits agree in substance, that is, in respect of the scope of the Beach claims 1, 2 and 3. Judge Lacombe, in speaking for the Court of Appeals in the Second Circuit, says (p. 360, Cert. Rec.), referring to the first three claims of the patent: "As to the "first set, therefore, the only question is, whether in veiw of "the state of the art, Beach was entitled to appropriate as "broad a combination as he has set forth in his first three "claims which cover every device for affixing stay-strips to "the outside of box corners, where the operation is performed "by the combined action of a feeding mechanism, a cutting "mechanism, and a pasting mechanism, in combination with "any opposing clamping-dies whose faces diverge. The Cir-"cuit Court sustained these broad claims, and we concur in "this decision."

Judge Colt, in speaking for the Court of Appeals in the First Circuit, said: "Upon a state of facts in which the prior "art was fully presented, the Circuit Court of Appeals for the "Second Circuit, sustained *on broad grounds, and, as we think "rightly*, the validity of the first three claims of the Beach "patent," and, such being the opinions of the two Courts of Appeals, the expressions of Judge Putnam in the Circuit Court, are not the subject for consideration or review by this Court. Concerning this, however, I shall make reference in my argument.

TENTH.

The grounds stated in the tenth section of the petition, in substance, is, that the feeding mechanism of defendant's machine is not the equivalent of the feeding mechanism of the Beach patent.

Yet the Court of Appeals in the Second Circuit, held, as did the Patent Office, that the Knowlton Machine with its back gripper feed was the equivalent of the side feed of the Beach patent.

The Court of Appeals in the First Circuit also held that the back gripper feed of defendant machine was the equivalent of

the Beach feed of his patent. Consequently no conflict of opinions appears between those of the two Appellate Courts.

ELEVENTH.

The grounds stated in the eleventh section of the petition respecting the alleged new feeding mechanism contained in defendant's machine, of non-anticipation, etc., are erroneous. The Knowlton Machine, which was put in interference with the application of Beach in 1888, contained substantially the same gripper feeding mechanism, (see claim 11 and 12, P. 310 Rec.) as that which is now claimed by the petitioners. Knowlton's claims for feeding device were rejected upon the old patent to Van Geasen of July 4th, 1877, No. 192,793, for feeding mechanism. (See page 313 Record). As was said by the Court of Appeals in the First Circuit: "*Horton, in his "patent, under which defendants manufacture, make no claim "to the feeding mechanism.*"

Knowlton's Feeding Mechanism is described in his specification, pp. 301–302 of the Record. The feeding devices in the Van Geasen patent of 1877 and the feeding devices, shown in figures 2, 3 and 5 of the Horton patent of 1890, are strikingly alike in construction and mode of operation, as will appear upon examination. It is submitted that there is no such conflict of opinion respecting the feedihg mechanism as to require a "review" of this feature of the case. (Concerning this question, more will be presented in the argument to follow.)

TWELFTH.

The twelfth assignment in the petition respecting the scope given to the first three claims of the Beach patent by the Court of Appeals in the First and Second Circuits, and the suggestion therein concerning prospective liability, appears premature—an attempt to cross a bridge before reaching it. A construction has been given to the scope of the first three claims of the Beach patent by the Circuit Court of Appeals in three cases without a dissenting opinion. Such being the fact, why should this Court be asked to review the decision of the Appellate Court below?

The Court of Appeals has decided that the feeding mechanism of defendant's machine is the equivalent of the feed of the Beach patent; and now petitioners are asking this Honorable Court to decide a moot question, without even stating the character of the imaginary feeding mechanism they may have in mind, or wish to make.

We submit that the proper course for petitioners, is, to make their imaginary feeding mechanism, and let the courts determine an actual case presented upon pleadings and proofs in the usual way, rather than expect this Court to advise them concerning matters and things not before it, nor, in existence. Certainly, known equivalents are embraced by the claims of the Beach first three claims, and it is respectfully submitted, that even a new form of feeding mechanism that served the purpose of the Beach feed in the same combination of factors operating in substantially the same way, would also be an equivalent, in view of the fact that Beach holds a patent for a pioneer invention; consequently, it becomes a proper question for discussion, only, when such a case, showing modifications, is brought to the attention of the Court in the usual way.

Thirteenth.

The thirteenth section of the petition appears frivolous on the same grounds and for the reasons stated respecting the twelfth section, which will be referred to in our argument. We submit, however, that it is in effect asking the Court to assist petitioners by pointing out a way for the alteration of their machines to escape infringement.

Fourteenth.

The fourteenth section of the petition, is a request for this Court to review the decisions of the Commissioner of Patents, and that of Judge Putnam, in Circuit Court, respecting limitations of the first three claims of the Beach patent, whose decisions have already been considered and determined by the Court of Appeals in three different cases, without a dissenting opinion. Beach *v.* American Box Machine Co. *et al.*, 18 C.

C. A. ; Beach *v.* Horace and Harry Inman, 24 C. C. A, 408 ; Beach *v.* Hobbs Mfg. Co. *et al.*, C. C. A., 92 ; Fed. Rep., p. 146.

FIFTEENTH.

The substance of section fifteenth of the petition, is a request for this Court to review the decisions of the Commissioner of Patents, Judge Coxe in the Circuit, and also decisions of the Court of Appeals which were rendered without a dissent in the First and Second Circuits in three different cases respecting the legality of the first claim of the Beach patent, who, and each of the tribunals held that it was a lawful and valid claim, therefore no conflict of opinions concerning this question.

SIXTEENTH.

The substance of section sixteen of the petition relates to the second claim of the Beach patent, suggesting that it is invalid. This question, like that set out in the fifteenth section, has been disposed of by the tribunals last mentioned, without dissent, who and each of them declared its validity.

SEVENTEENTH.

The seventeenth section of the petition suggests that the third claim of the Beach patent is the only one that sets forth "**all**" the elements found in petitioner's machines,—it is unnecessary to state "**all**" of the elements found in an infringing machine,—it is sufficient evidence of infringement where (as in the present case), the number of elements less than "**all**" are found in the infringing machine in the same arrangement and combination set forth in the claims of the patent sued upon. An argument is unnecessary upon this point.

EIGHTEENTH.

The subject matter set forth in the eighteenth section of the petition has been fully considered by Judge Coxe in the second Circuit, and also by the Circuit Court of Appeals in three different cases without a dissenting opinion. (See Beach *v.*

American Box Machine Company *et al.*, 63 Fed. Rep., 597; same case on Appeal, 18 C. C. A., 165; 71 Fed. Rep., 240; also by Judge Cox in Beach *v.* Inman M'f'g Co. *et al.*, 75 Fed. Rep., 840; same case on Appeal, 24 C. C. A., 408, 75 Fed. Rep., 840; Beach *v.* Hobbs *et als.*, C. C. A., and 92 Fed. Rep., 146,

NINETEENTH.

The first and second subdivisions of section nineteen of the petition were fully discussed before and considered by the Court of Appeals in the First Circuit, and the third and fourth subdivisions thereof were also carefully and fully considered by the Circuit Court of Appeals in the cases of Beach *v.* American Box Company; Beach *v.* Inman M'f'g. Company *et als.*, and Beach *v.* Hobbs M'f'g. Company *et als.* (*supra*), who, notwithstanding strenuous contentions of counsel for defendant in the respective cases on precisely the same point, decided for complainant without a dissenting opininion in either of the cases, consequently are not subjects for review.

TWENTIETH.

The question suggested in the twentieth section of the petition concerning the validity of the sixth claim of the Beach patent was fully considered and disposed of by Judge Putnam in the Circuit Court, and also by the Circuit Court of Appeals, who approved the decision of Judge Putnam without a dissenting opinion, who upheld the validity of the claims. It is, therefore, submitted that no question is presented requiring review. Reference will be made to this question in the argument.

TWENTY-FIRST.

The statement appearing in the twenty-first section of the petition appears frivolous; reference will, however, be made to this subject in my brief.

TWENTY-SECOND.

The point suggested in the twenty-second section of the petition concerning the right of the appellant to amend his

application after his contests before the Patent Office with others claiming the same invention, who, in the meantime was powerless and prevented from properly amending his application until after the final disposition of the several interference proceedings, is insufficient as a point for review, which subject, will be discussed in the argument to follow.

TWENTY-THIRD.

The suggestions set forth in the twenty-third section of the petition concerning questions of priority of invention, etc., between Horton and Beach, is of no moment here whatever, the proofs, however, are sufficiently clear and full upon these points to dispose of this feature of the case without argument, Horton did not attempt to claim the invention of Beach, he filed and accepted claims with limitations of a character that clearly showed his acquiesence in the broad claims allowed Beach by the Patent Office, the principal ones of which had been made public by the interference proceedings long prior to his (Horton's) application for a patent.

It is, therefore, respectfully submitted on behalf of respondent that petitioners have failed to show errors of a character justifying the granting of the prayer of their petition.

Summary of the Petition.

Sections 1, 2, 8, 9, 10, 12, 13, 14, 15, 16, 17, 18, 19, 20, 21, 22, 23, are absolutely destitute of sufficient or proper grounds to support the petition.

The Court of Appeals disposed of the questions raised in the 7th, 15, 16, 17, 18, 19, 20 and 22nd, without a dissenting opinion.

Sections 3, 4, 5, 6 and 10 of the petition are mixed questions of law and fact, although they have been passed upon by the Courts of Appeals without a dissenting opinion.

Brief and Points of Law on Petition.

The points of law involved in this case are not difficult to understand, and it has not been shown that it has been misapplied to the facts in the case sought by the petitioners to be reviewed. Therefore the petition should be dismissed. (United States *v.* Perrin, 131 U. S., p. 58.)

The points raised and set forth in the petition are for the most part mixed questions of law and fact, therefore not a matter for review by this Court,—moreover, the points are destitute of that clear, distinct presentation of questions of law which this Court has so often held to be necessary to invoke the action of this Court. United States *v.* Perrin, 131 U. S., p. 57.

This Court has frequently held that mixed questions of law and fact are not to be entertained in cases similar to the one at bar. Wilson *v.* Barnum, 18 How., p. 258 ; Paving Co. *v.* Moliter, 113 U. S., p. 615, and cases cited.

Argument.

The decisions of the Court of Appeals for the First and the Second Circuits bearing upon the scope of the first three claims of the Beach Reissued patent, do not present a question of such a character as to invoke the powers of this Court and call it into action for the purpose of determining differences that are not material to the issues in the case, and especially which have been carefully considered and disposed of by the Appellate Courts below. The question (among others) considered by Court of Appeals in the respective Circuits, was, whether or not, certain combination of elements found in defendants' machines were embraced by the first three claims of said Beach patent, in view of the fact that there were differences in the forms of some of the elements of the respective combinations in complainant's and defendants' machines, the object, general arrangement in their relations to each other, main purpose and results, being the same in both. Upon the

evidence presented to the United States Circuit Court of Appeals (in the cases of Beach *v.* American Box Company *et al.*, 18 C. C. A., p. 169; Beach *v.* Horace Inman *et als.*, 24 C. C. A., p. 408; Beach *v.* Hobbs Mfg. Co. *et al.*, C. C. A., 92 Fed. Rep., 146) by which the validity and scope of the said three claims were considered by a full bench in each instance, and before whom careful and elaborate presentations of the facts and law were made by eminent counsel for defendants,—and in each case, the **validity** of the respective claims was declared by the Court and the machines of defendants were held to contain the combinations thereof. **Beach established a new art and produced the first machine for use in that art, consequently a pioneer invention for which he applied for and secured a patent after a protracted siege of litigation extending over a period of many years.**

From the character of the petition and brief in the present case, petitioners are seeking to have this Court review the entire case which has been disposed of by the Court of Appeals without a dissenting opinion upon any point. It is contended, however, that a course such as is suggested, is counter to the present rules of this Court.

Refering to the suggestion contained in the twelfth section of the petition, to the effect, that, as the decisions now stand in the First and Second Circuits, petitioners do not know how they can safely proceed with the sale of corner staying machines, because in the First Circuit, the Court of Appeals has decided that their machines contain the combinations of the first three and the sixth claims of the Beach patent, and that Beach is entitled to equivalents of the elements and combination of the said first three claims of the patent requires but little comment we submit, however, that as the Court of Appeals has decided that the claims of the Peach patent sued upon have been infringed by defendants' machines, and, that the differences suggested by defendants' counsel which were held to be immaterial, being equivalents of those of the patent, no material question is presented for review.

The law pronounced by the Appellate Courts in the First

and Second Circuits prohibit petitioners from using combinations that are equivalents of the parts and combinations described in the first three claims of the Beach patent, there is no conflict upon this point. Notwithstanding this fact, petitioners present a novel problem for the consideration of this Court, which is (in substance), that it point out, or, suggest a combination of elements, or, what modification thereof will be **without** and **not within** the scope of the first three claims of the Beach patent, that they can market or sell in the First and Second Circuits.

In short, they are asking this Court to apply rules of law to hypothetical questions which are not even shown or explained. We submit that it is timely, only, when petitioners have made a machine **substantially different from the old,** that does not contain the same, nor the equivalent devices and combinations of the Beach patent.

The feeding mechanism of defendants' machines was not new at the date of the Horton application as we have hereinbefore stated, it appeared in the application of M. D. Knowlton filed February 14th, 1888, Horton application filed March 28th, 1890, over two years later. Knowlton claimed the feeding mechanism which is now claimed by counsel for petitioners to be new (see Knowlton claims 11 and 12, page 313 Record), which claims were rejected on Van Geasen patent of 1877, which patent shows substantially the same feeding mechanism as the Horton, which patent was before the Court of Appeals in this case. **Horton did not apply for, and does not present any claim for it in his patent, and does not even state that he thought it to be new with him, and this fact is referred to by Judge Colt in speaking for the Court of Appeals in its opinion.** 92 Fed. Rep., page 146.

It is respectfully submitted that the record in this case clearly shows that the feeding mechanism of petitioners' machine is the equivalent of the Beach feed of his patent as a matter of law, and such, has the full endorsement of the Court of Appeals in the opinion stated by Judge Colt.

It would seem that further discussion of this feature of the

case is unnecessary as the contention of the petioners is without merit.

☞ The supposed limitations to the first three claims of the Beach patent suggested by the petitioners are not borne out by the facts—the language of the claims are clear, and cannot readily be misunderstood—they speak for themselves in terms—the specification of the patent at page 610, folios 25–30 of the Record sets forth full notice to the public that the patentee does not limit himself to the particular mechanism described and shown, but that other devices of other forms may be used—this does not indicate that the Commissioner of Patents was intending to, or did restrict the applicant and patentee as suggested by counsel for petitioners, but on the contrary,—which is shown by the grant and issue of the patent containing the claims and notice referred to.

The action of the Commissioner of Patents upon this question has had the full endorsement of the Circuit Court of Appeals in three (3) cases and also that of Judge Coxe in the Circuit Court; it is therefore believed that further discussion of this subject is unneccessary, except, we might add that there is nothing in the Record to show that Beach acquiesced in any suggested limitation; however, whatever there is, relating to acquiesence is contrary to the suggestion, and the Record shows that the suggested amendment was not adopted.

Respecting the question of invalidity of the first three claims of the Beach patent suggested at pages 8 and 9 of Petitioners brief, it will appear from the Record (pages 246 and 247) that broad claims were filed by Beach May 4th, 1886, which was prior to the filing of any application for a patent by others containing and claiming combinations the same or similar to those set forth in the said Beach pending application, thus it will be seen that Beach laid his foundation for his broad claims before any other applicant appeared in the Patent Office, and in fact before any other invention for a like or similar purpose had been made. Such being the fact, it is submitted that the theory of petitioners is not good in law and that the decisions of the Circuit Court of Appeals in the three cases hereinbefore referred are correct.

The several prior patented machines and combinations referred to in the petitioners brief at pages 9 and 10 were fully discussed and considered in each of the three appeals in the First and Second Circuits before full benches who held that none of them anticipated any of the claims of the Beach patent in issue. (The claims considered by the Court of Appeals in the Second Circuit were 1, 2, 3, 4, 5 and 7, and in the Court of Appeals in the First Circuit claims 1, 2, 3 and 6 of the Beach patent).

Concerning the reissues of the Beach patent, it is submitted that in justice to the public he was fully justified in placing before the public such a recipe or specification as would clearly and unmistakably convey to their minds the correct manner of constructing his invention for practical operation.

Beach discovered that an error had been inadvertently made in the drawing of the patent which, if followed, would result in an inoperative machine, consequently render it possible, and in fact probable, that infringers would take advantage of the fact as a defence in the event of a suit brought under it.

A machine however constructed in accordance with the defective original patent would be wholly impracticable, as the box corner to be treated could not be put into position upon the form to receive the necessary stay-strip, neither could the stay-strip be compressed as required, nor could the corners of the box be shaped and squared as intended.

"**Power to surrender patents** for the purpose sug-
"gested in the Act of Congress implies that such may be cor-
"rected to the extent necessary to cure the defects and to
"supply the deficiencies to render the patent operative and
"valid. * * * The purpose of a surrender and reissue is
"not to introduce new features, ingredients and devices, but

"to render effective the actual invention for which the original "patent should have been granted." Justice Clifford in Collar Co. *v.* Van Dusen, 23 Wall, p. 257. The law requires of the applicant a careful and correct description of the structure he wishes to patent, such a one that could be clearly understood by those who might desire to construct and practice the invention without being compelled to resort to experiments, consequently a patentee on finding its descriptive parts defective and erroneous in essential features is bound (in justice to the public) to correct the errors by reissue.

And this is precisely what Beach has done, and nothing more. His act in this regard was justifiable and commendable, and the principle sound.

The suggestion which appears in the brief of petitioners (pp. 13–14) to the effect that the record does not show whether Beach or Horton was the prior inventor of the combinations set forth in claims 1, 2, 3, and 6 of the Beach patent cuts no figure of importance here; although *the record does show that Beach made his first stay machine in accordance with patent in the fall of 1885, and put it into practical use in the spring of 1886, producing therewith more than 30,000 Boxes* (Beach Dep., p. 96, Q. A.), 3, 4, 5). *Horton admits that he had a Beach stay machine in his shop in the early part of 1889* (Horton Dep. p. 38, x Q. 53, 54), *and that he* (*Horton*) *made his first stay machine about October, 1889* (the latter part of the year). (Horton Dep., p. 35 x Q., A. 36, 37.

With these facts before us, it is obvious why Horton did not undertake to claim the combinations which he had for the first time seen in the Beach machine.

His conduct, possession of a Beach machine in the early part of the year 1889, and patent which he accepted, all indicate why he limited his claims, so as to avoid an interference with the application of Beach. Had Horton considered himself the first inventor of the combinations claimed by Beach, he would have drawn his claims accordingly and requested an interference with the application or patents granted which he believed

to be subsequent to him in point of priority in time of invention, but this he did not do for obvious reasons. The characacter of his claims with their limitations are not by any means the claims of Beach either in substantial scope or otherwise. Horton appeared upon the field long after it had been entered by others who had made their applications for patents for combinations for the same purpose as those of the Beach patent with whose application they had been put in interference and defeated. Among the latter, were the applications of J. C. Marshall, of Rochester, N. Y., pending March 7th, 1887 (p. 254, Rec.). Gustav Jaeger, New York, pending Dec. 27th, 1887 (p. 259, Rec.). M. D. Knowlton, Chicago, Ill., pending prior to Feb. 15, 1889 (p. 259, Rec.). David Rece, Amsterdam, N. Y., pending prior to Feb. 15th, 1889 (p. 259, Rec.). Horace Inman, Amsterdam, Feb. 15, 1889. English patent to Knowlton of April 5th, 1888 (p. 593, Rec., noticed). English patent to Gustav L. Jaeger, April 5th, 1888 (p. 573, Rec.), all of which dates are prior to the time that Horton made his first stay machine. These facts would seem to be a sufficient answer to the suggestion of petitioners' counsel why no interference between the applications of Horton and Beach and also as to the question of priority of invention.

In Conclusion.—It is submitted that there is no such a conflict of opinions presented in the petition as to warrant the grant of the writ as prayed, for the following reasons: (1) The language of the Court of Appeals in Beach *v.* American Box Company, *et al.* (18 C. C. A., p. 169) should be considered in the light of its intendment in connection with the facts and proceedings before that Court, and the words expressed by it as to the scope of the first three claims of the Beach patent, are not unreasonable, considered in the light of the fact that Beach was clearly shown to be (as a result of his many, and long contests), the very first person who ever made a machine capable of doing the work of staying the corners of paper boxes with short strips of paper which had always theretofore been done by hand.

The criticism of petitioners' counsel respecting the opinion

by Judge Lacombe (pp. 360–361, Rec.) is a strained effort to give the suggested error a greater magnitude than what it possesses, the language is clearly expressed, he refers to the elements, character, and scope of the first three claims of the patent, and says, that **there are broad ones,** and then winds up with these words, **"The Circuit Court sustained these broad claims, and we concur in this decision."** This quotation is the real gist of the decision, and it goes no further than what the words quoted express, the preliminary words and language referring to these claims were used in illustration of the character of the factors of the combinations only.

The opinion of the Court of Appeals in Beach v. Inman (24 C. C. A., p. 408), taken in connection with the opinion of Judge Coxe (75 Fed. Rep., p. 840), discloses no such broadening of the scope of the first three claims as suggested by petitioners' counsel in their brief. The evidence in that case clearly showed that the roller form of die was the plain mechanical equivalent of the vertical acting die. The Courts applied the rules of law accordingly.

The comparison of the first three claims of the patent, with those presented by petitioners' counsel (in their brief) as proper ones for Beach *under their theory*, requires no comments from us in view of what has been already said concerning the claims, interferences, contests, decisions, etc.

The machine of the Beach patent is of the compound order, adapted to serve two different purposes in the aplication of stay-strips to the corners of the box; that is to say, when desirable, it will apply the strip upon the outside and the inner corners at one and the same operation, yet, the operation of the mechanism for staying the "inner corners" may be suspended when desirable and not be brought into play, while the other combinations are applying the strips outside only, or the mechanism for inner staying may be left out of the machine entirely as the constructor or user may desire. This fact is alluded to only for the purpose of enabling this Court to better understand how to treat the subject which appears upon the last half of page 8 of petitioners' brief, relating to "a wholly new kind of a machine, etc.,". It should be remem

bered that the "claims" covering the outside staying mechanism were made and filed before a stay machine had been even made by others, or an application for a patent filed. It is, therefore, submitted that there was no error of law granting the claims in question. The authorities cited in the brief of petitioners are not in point here.

Respondent has shown that the Circuit Court of Appeals in the Second Circuit in two different suits, and the Circuit Court of Appeals in the First Circuit in another suit (all involving the three claims of the Beach patent) held, without a dissenting opinion, that (1) Beach was a pioneer and the very first to invent and produce a machine for doing a work which had always theretofore been done by hand, and (2) that the first three claims of the Beach patent were broad ones, and (3) that the said claims embraced other devices equivalents of those constituting the combinations thereof, and (4) that the first and second claims thereof are valid and operative combinations, and (5) that the location of the feeding mechanism at the rear instead of at the side of the machine for advancing the strip to the box corner were the same in law, and (6) that the differences in the form of the feeding mechanism found in defendants' machines were insufficient to avoid the claims thereof; and (7) that the Reissue of the Beach patent to correct the error and defect was lawful and proper; and (8) that the Beach Reissued patent is good and valid in law, and (9) that none of the alleged anticipating patents or machines set up as defenses embodied the invention of the claims, nor were they capable of performing the work or any for which the machine of the Beach patent was intended.

The comments of the Court of Appeals in the Second Circuit appearing in its opinion concerning the character and scope of the said first three claims are in the nature of a dicta. Therefore, the words are not embraced, as will appear upon examination, in the concluding statements forming their decision, to wit: **"The Circuit Court sustained these "broad claims and we concur in this decision."** It therefore follows that the opinion of Judge Coxe forms the basis for the words just quoted, an examination thereof, dis-

closes the fact that there is no conflict between the decisions of the Courts of Appeals in the First and Second Circuits.

The law of this Court relating to applications for patents, character and scope of their claims, Reissues, etc., has been followed by the Court of Appeals in the application of law to this case. Reference to the opinions embodying the law as defined by this Court, applicable to the different features of the present case will be omitted, excepting upon the question of equivalents, and to this question we refer to the following cases in support of our position :

O'Reilly *v.* Morse, 15 How., p. 15.
Machine Co. *v.* Murphey, 94 U. S., p. 123.
Imhauser *v.* Buerk, 101 U. S., p. 655, and others.

To the question of reissue, applicable here and in support thereof, are the cases of :

Collar Co. *v.* Van Dusen, 23 Wall., pp. 256–258.
Miller *v.* Br[illegible]Co., 104 U. S., pp. 353–358.
Topliff *v.* Topl[illegible]145 U. S., p. 171,
and others.

As previously stated the Circuit Courts in three different suits considered the question of the Reissue of the Beach patent and held that it was proper and lawful, and their decisions respecting this feature of the cases were affirmed by the Circuit Court of Appeals in each instance.

To the suggestions set forth in subdivision four (4) of Section eleven (11) of the petition, respondent asserts most emphatically that the so-called Horton feeding mechanism has been applied to a machine made in accordance with the Beach patent without alteration or change in any of the other parts composing the combination of the claims and it operated and performed the function of feeding the strips in the same manner as the feeding mechanism of the Beach patent. **No error has been shown to have been committed by the Court of Appeals.**

It is, therefore, respectfully submitted that the Petition for the Writ of Certiorari should be dismissed.

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